

TRADE MARKS ORDINANCE (Cap. 559)

APPLICATION NO.: 300010952

MARK: “• the Game Des!gners Studio & device”

CLASS: 9, 16, 28 AND 41

APPLICANT: KABUSHIKI KAISHA GAME DESIGNERS STUDIO
(THE GAME DESIGNERS STUDIO, INC.)

STATEMENT OF REASONS FOR DECISION

Background

1. On 25 April 2003, Kabushiki Kaisha Game Designers Studio (The Game Designers Studio, Inc.) (“the applicant”) applied, pursuant to the provisions of the Trade Marks Ordinance (Cap.559) (“the Ordinance”), to register the mark, a representation of which appears below :



(“the subject mark”) in Classes 9, 16, 28 and 41. The goods and services for which registration is sought are as follows:

Class 9

computer game software; video game software; sound recordings in the form of optical discs, magnetic discs and semiconductor ROMS featuring music and/or entertainment; audio visual recordings in the form of optical discs, magnetic discs and/or semiconductor ROMS featuring music, animation and/or entertainment; prerecorded compact discs featuring music; prerecorded digital video discs featuring music, animation and/or entertainment; prerecorded video cassettes featuring music, animation and/or entertainment; decorative magnets; mouse pads; straps for cellular phones; sunglasses; video game players; keyboards; joysticks; video game controllers; downloadable computer graphics; downloadable animation; downloadable music; connectors to connect hand-held video game units with other video game machines; all included in Class 9.

Class 16

computer game strategy guidebooks; video game strategy guidebooks; books featuring fictional stories; comics; magazines; pamphlets; brochures; posters; stickers; banners; calendars; postcards; collectors' cards; trading cards; photographs; photograph stands; stationery; all included in Class 16.

Class 28

dolls; toy figures; stuffed toys; inflatable toys; toy vehicles; toy guns; playing cards; card games; board games; hand-held video game units; carry cases for carrying hand-held video game units; all included in Class 28.

Class 41

providing on-line computer games and video games via computer networks and/or global communications networks; providing information on computer game strategies and/or video game strategies via computer networks and/or global communications networks; providing information on computer games and/or video games via computer networks and/or global communications networks; all included in Class 41.

2. Objection was taken against the application under section 11(1)(b) of the Ordinance because the mark is devoid of any distinctive character for the goods and services relating to games.
3. A hearing was held on 31 August 2004 at which the applicant was represented by Mr. Cheng Chung Yung of Messrs. Hastings & Co. I reserved my decision at the conclusion of the hearing.
4. Mr. Cheng provided at the hearing an extract dated 23 August 2004 from a website showing the use of the subject mark for my background information. However, I note that the extract is after the date of application for registration, so it does not satisfy the requirement under section 11(2) of the Ordinance. In addition, the extract is not in the form of statutory declaration as required by rule 79(1) of the Trade Marks Rules (Cap.559A). Therefore, I take that there is no evidence of use before me and I have only the *prima facie* case to consider.

Trade Marks Ordinance

5. The relevant part of the Ordinance under which the objection was taken is as

follows:

Section 11(1):

“The following shall not be registered-

(b) trade marks which are devoid of any distinctive character.”

Applicant’s submissions

6. Mr. Cheng’s main submissions were as follows:

- (a) The applicant did not dispute that the words “Game Designers” might be indistinctive and descriptive in respect of the goods and services applied for relating to games. Nevertheless, when conjoined with the word “Studio”, the combination was unique and novel which warranted registration.
- (b) It was the applicant who first devised the phrase as its own brand in the market. It was unlikely that other traders would want to use a mark identical with or resembling the subject mark in their daily business activities unless with improper motive.
- (c) In assessing the distinctiveness of a mark that combines a number of elements, the mark must be regarded and considered as a whole.
- (d) Visually, the subject mark was a composite one which featured the expression “the Game Designers Studio” rendered in a particular and stylised manner and in combination with accompanying artwork. The manner of representation was out of the ordinary so as to strike the eye as peculiar, and thus rendered the mark distinctive as follows: -
 - (i) the phrase “the Game Designers Studio” was put into a black and white rectangular bar with sharp colour contradiction;
 - (ii) the letter “i” in “Designers” was replaced by an exclamation mark;
 - (iii) the stylisation of the word “Studio” was fancy and attractive.
- (e) When viewing the subject mark as a whole, it was unusual and memorable and did possess a minimum degree of distinctiveness. If the subject mark was distinctive to the eye as a matter of first impression, it could not be said to be devoid of any distinctive character.

- (f) Mr. Cheng quoted the trade marks, “FUNWORKS STUDIO” (2003B13628), “THE SERVICES FACTORY” (2003B05387), “TOY FACTORY & device” (1997B00576) and “THE CHEESECAKE FACTORY” (2000B04482) on the register, which were registered on a prima facie basis. Copies of the register entries relating to those marks were produced. He requested the Registrar to apply the same principle on examining the present application with a view to maintaining a consistent approach in the treatment of similar cases.
- (g) The applicant’s corresponding applications for the subject mark had also been accepted for registration in the Australian Trademark Office (‘ATMO’) and the Office for Harmonization in the Internal Market (Trade Marks and Designs) (‘OHIM’). Copies of the relevant printouts obtained from the database of those offices were produced for my reference. Mr. Cheng understood that the registrability criteria in Australia and that under the Community Trade Mark system might be different from that of Hong Kong and the Registry was not bound to follow suit. However, the distinctiveness requirement and the prohibition of marks with descriptive connotation were similar to the Ordinance. The Registrar should give due weight to the relevant decisions. Moreover, the examiners in those offices were more familiar with the English language and hence could examine the subject mark more comprehensively and accurately noting all possible connotations which might be descriptive and hence objectionable. If the examiners in those offices had allowed the subject mark for registration, this would mean that the subject mark was distinctive and free from descriptive connotations and should therefore qualify for registration in Hong Kong as well.
- (h) The applicant did not intend to claim any right to the exclusive use of the words “Game Designers” and “Studio” and was prepared to offer a separate disclaimer thereof. However, if this was still unacceptable, the applicant was willing to disclaim “the Game Designers Studio” but asked for the protection of the subject mark in the particular graphical representation as a whole. The applicant believed that the grant of the registration with the entry of appropriate disclaimers would not affect or interfere with the legitimate rights of other traders to adopt and use such term to describe and promote their goods/services normally and reasonably.

Ms. Cheng also confirmed that the applicant was not prepared to restrict the specification as proposed in the Registrar's opinion of 28 July 2003.

Decision

7. In the present application, the Registrar raised the objection under section 11(1)(b) of the Ordinance, as the subject mark is considered to be devoid of any distinctive character for the goods and services relating to games.

Test for section 11(1)(b)

8. In *British Sugar Plc v James Robertson and Sons Ltd* [1996] RPC 281 at page 306, Jacob J said :

“What does *devoid of any distinctive character* mean? I think the phrase requires consideration of the mark on its own, assuming no use. Is it the sort of word (or other sign) which cannot do the job of distinguishing without first educating the public that it is a trade mark?”

9. In “*Cycling IS...*” *Trade Mark Applications* [2002] RPC 37, it was stated that:

“It thus appears to be legitimate, when assessing whether a sign is sufficiently distinctive to qualify for registration, to consider whether it can indeed be presumed that independent use of the same sign by different suppliers of goods or services of the kind specified in the application for registration would be likely to cause the relevant class of persons or at least a significant proportion thereof, to believe that the goods or services on offer to them came from the same undertaking or economically-linked undertakings.”

10. The approach of assessing distinctiveness was further discussed in *Nestle SA's Trade Mark Application (Have a Break)* [2004] FSR 2:

“The distinctiveness to be considered is that which identifies a product as originating from a particular undertaking. Such distinctiveness is to be considered by reference to goods of the class for which registration is sought and consumers of those goods. In relation to the consumers of those goods the court is required to consider the presumed expectations of reasonably well informed, and circumspect consumers.”

11. In view of the above legal principles, distinctive character means, for all trade marks, that the mark must be capable of identifying the product as originating from a particular undertaking, and thus distinguishing it from those of other undertakings. I must assess the mark's distinctiveness in relation to the goods and services for which the applicant seeks registration taking into account the presumed perception of the relevant consumers.

Relationship between sections 11(1)(b) and 11(1)(c)

12. At the hearing, Mr. Cheng quoted the following statements from paragraphs 39 and 40 of the *BABY-DRY* decision [2002] RPC 17 in support of the application:

“A mark composed of signs or indications satisfying that definition should not be refused registration unless it comprises no other signs or indications and, in addition, the purely descriptive signs or indications of which it is composed are not presented or configured in a manner that distinguishes the resultant whole from the usual way of designating the goods or services concerned or their essential characteristics.”

“Any perceptible difference between the combination of words submitted for registration and the terms used in the common parlance of the relevant class of consumers to designate the goods or services or their essential characteristics is apt to confer distinctive character on the word combination enabling it to be registered as a trade mark.”

13. I brought to Mr. Cheng's attention that the objection raised by the Registrar in the present application was under section 11(1)(b) of the Ordinance but the above statements concerned Article 7(1)(c) of Council Regulation (EC) No.40/94 (which is similar to section 11(1)(c) of the Ordinance). Mr. Cheng responded that sometimes there might not be a clear-cut distinction between sections 11(1)(b) and 11(1)(c) and they might overlap in certain respects. He referred to the *BABY-DRY* decision and argued that the subject mark with surplus elements could make the subject mark as a whole acceptable for registration.
14. I do not think that the above statements or principles from the *BABY-DRY* decision assist the applicant's case. In *Nestle SA's Trade Mark Application*

(Have a Break) [2004] FSR 2, Mummery L.J. said that “In the *BABY-DRY* case the Court of Justice held that the word mark did not fall foul of the requirement in Art.7 1.(c) of the Council Regulation that a mark should not designate the characteristics of the goods. But there was no issue before the Court of Justice in that case as to whether the mark was “devoid of any distinctive character.”

15. In *Telewest Communication Plc’s Trade Mark Application* [2003] RPC 26, Geoffrey Hobbs Q.C. acting as the Appointed Person also commented that “I consider that the *BABY-DRY* judgment addresses the scope of the objection prescribed by s.3(1)(c) of the Act¹ and does so without laying down any general rule to the effect that signs which are not wholly descriptive should, for that reason, be regarded as distinctive and therefore free of objection under s.3(1)(b) of the Act².”
16. In the present case, the subject mark is objected to solely under section 11(1)(b) of the Ordinance. The fact that by virtue of the way the subject mark is presented, it is not considered to be exclusively descriptive and objectionable under section 11(1)(c) does not mean that it is therefore free of objection under section 11(1)(b). As Mummery L.J. said in *Nestle SA’s Trade Mark Application (Have a Break)* [2004] FSR 2: “The two grounds, although they no doubt overlap to some extent, are independent grounds for refusing registration. They have to be separately examined and considered. A mark may not be exclusively descriptive of the relevant goods or services and so not fall foul of s.3(1)(c), but it may nevertheless be “devoid of any distinctive character” and so fall foul of s.3(1)(b).”

The subject mark

17. The subject mark comprises the expression “the Game Des!gners Studio” with a little white dot before the word “the”. The little dot and the word “the” in white are placed inside a black rectangle. The words “Game Designers” in black are placed inside a white rectangle. The letter “i” in the word “Designers” is replaced by an exclamation mark. The word “Studio” mostly in white is set against a black rectangle and its typeface is different from that of the other words in the subject mark.

¹ which is in similar terms to section 11(1)(c) of the Ordinance

² which is equivalent to section 11(1)(b) of the Ordinance

18. I agree with Mr. Cheng that in assessing distinctiveness of a mark, the mark must be considered as a whole. However, in order to assess the impact of the whole on the public, it is proper to consider the separate integers of a mark and, then, whether any objection to them is subsumed into the totality (see *BONUS GOLD Trade Mark* [1998] RPC 859).

19. Firstly, I consider the words in the subject mark. According to *The Collins English Dictionary (Third edition)*,

“game” means:

- an amusement or pastime; diversion;
- a contest with rules, the result being determined by skill, strength, or chance;
- equipment needed for playing certain games

“designer” means:

- a person who devises and executes designs, as for works of art, clothes, machines, etc.

“studio” means:

- a room in which an artist, photographer, or musician works

20. Mr. Cheng submitted that the combining of the word “Studio” with the words “Game Designers” was unique and distinctive. I cannot agree. “Studio” is a place where an artist works. A “designers studio” is an apt description of an establishment involved in artistic or other creative design. The words “game designers” merely indicate the particular field of design, namely the design of games, in which the applicant is involved. Just as it is natural to refer to fashion designers studio, jewelry designers studio, web designers studio or hair designers studio, the words “game designers studio” is a natural way of referring to an undertaking specialized in the design of games. Those words can be applied with equal truth to any other studio or trader involved in such business, and therefore does not serve to identify the goods and services as originating from a particular undertaking.

21. Mr. Cheng argued that the phrase “the Games Designers Studio” was first devised by the applicant and it was unlikely that other traders would want to use such a mark or a similar mark without improper motive. I consider that the words “the Games Designers Studio” is apt to describe any undertaking

involved in the business of designing games. I do not see why other traders would not desire to use those words in the course of their business. Those words do not serve to distinguish the applicant's goods and services from those of other traders.

22. I further consider the way the words are presented in the subject mark. At the hearing, Mr. Cheng submitted that as the subject mark was unusual, memorable and distinctive to the eye, it did possess a minimum degree of distinctiveness. His offer of the disclaimers referred to in paragraph 6(h) above indicates he considers that the particular graphical presentation of the subject mark gives the mark distinctive character.
23. The distinctiveness of a mark must, however, be considered by reference to the goods and services in respect of which registration is sought and by reference to the presumed perception of the relevant public.
24. The goods and services applied for mostly relate to games. They are for amusement and entertainment. Providers of these products would want to appeal to potential customers of these games by colourful, attractive and eye-catching get-up. Consumers for these goods and services would be accustomed to seeing packaging of these products and websites for these services decorated in a lively and even amusing way.
25. I consider the presentation of the subject mark as described in paragraph 17 above. Looking at the mark as a whole, the little dot is hardly noticeable. Though the letter "i" in the word "Designers" is replaced by an exclamation mark, the effect of the exclamation mark is diluted by other letters in the word. The black and white rectangles merely provide a background to and reinforce the words. The word "Studio", though in a slightly different typeface, is not distinctively stylised. Having regard to the nature of the subject goods and services as discussed in paragraph 24 above, all these features of presentation would not add materially to the impression created by the individual components. Taken whether individually or collectively, they are unlikely to cause the average consumer to consider that the subject mark as a whole has trade mark significance.
26. For the reasons stated above, I am of the view that the subject mark as a whole cannot perform the essential function of identifying origin before the public is

educated that it is so used for that purpose. The subject mark is devoid of any distinctive character and is thus barred from registration under section 11(1)(b) of the Ordinance.

Reference to other registered marks on the register and foreign registrations

27. I take note of Mr. Cheng's submissions and printouts in relation to four registered marks on the register. However, it is well established that each case must be considered on its own merits and not by reference to other marks that have been judged registrable on other occasions. In *British Sugar Plc v James Robertson & Sons Ltd* [1996] RPC 281 at 305, Jacob J said that "It has long been held under the old Act that comparison with other marks on the register is in principle irrelevant when considering a particular mark tendered for registration, see e.g. *MADAME Trade Mark* and the same must be true under the 1994 Act. I disregard the state of the register evidence."

28. I also note that the subject mark has been accepted for registration in other jurisdictions, namely Australia and the European Community. However, national trade mark rights are territorially limited and granted independently of each other. The bare fact of registration in other countries is not sufficient to establish that a sign is eligible for registration here (*Automotive Network Exchange Trade Mark* [1998] RPC 885). The Registrar is entitled to assess the meaning and significance of the given sign according to the circumstances prevailing in his own territory, it being recognized and accepted that assessments of such matters are liable to vary as a result of linguistic, cultural and social differences between territories ("*Cycling IS ...*" *Trade Mark Applications* [2002] RPC 37). Where there are valid reasons for refusing the application before me, I am not prepared to follow the decisions of other registries especially when reasons for those acceptances are not available to me.

Disclaimer

29. I turn now to the disclaimers offered by the applicant. Although the applicant is prepared to disclaim any right to the exclusive use of the words "the Game Designers Studio", the question I have to consider under section 11(1)(b) of the Ordinance is whether the subject mark as a whole has any distinctive character. As I have found that the subject mark as a whole is devoid of any distinctive character, the subject mark is barred from registration by virtue of section

11(1)(b) and the offer of the disclaimers referred to in paragraph 6(h) above does not assist the applicant.

Conclusion

30. In this decision, I have considered all documents filed by the applicant, the written and oral submissions made by Mr. Cheng at the hearing and the documents provided on behalf of the applicant. For the reasons given, the application is refused under section 42(4)(b) of the Ordinance because the subject mark is precluded from registration by section 11(1)(b) of the Ordinance.

Sandra Hui
for the Registrar of Trade Marks
21 February 2005